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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,211	11/21/2001	Timothy E. Benson	6241.N	4477

28880 7590 02/06/2006
WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR, MI 48105

EXAMINER

STEADMAN, DAVID J

ART UNIT PAPER NUMBER

1656

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/991,211

Applicant(s)

BENSON, TIMOTHY E.

Examiner

David J. Steadman

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

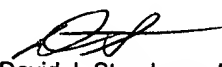
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6 and 54-69.
Claim(s) withdrawn from consideration: 21-43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


David J. Steadman, Ph.D.
Primary Examiner
Art Unit: 1656

ADVISORY ACTION

[1] The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1656.

[2] The amendment to the specification, filed on 8/18/2005, is acknowledged and has been entered into the application file. In view of the amendment, the objections to the drawing figures and the specification (see ¶¶ [11] and [13] of the Office action mailed on 5/18/2005) are withdrawn.

[3] The request for reconsideration in the response filed on 8/18/2005 has been considered, however, the amendment fails to place the application in condition for allowance for reasons that follow.

[4] The new matter rejection of claim(s) 54-61 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record and the reasons stated below.

RESPONSE TO ARGUMENT: Applicant argues claims 54 and 58 are directed to recited contiguous stretches of amino acids of SEQ ID NO:1. Applicant acknowledges gaps in the cited support for the recited range of amino acids and argues that not every amino acid must be disclosed.

Applicant's argument is not found persuasive. The amino acids listed in Tables 1-6, cited as support for claims 54 and 58 in the response filed on 3/1/2005, are disclosed as being selected amino acids "near" an FAD or an EP-UDPGlcNAc binding site in *S. aureus* MurB. There is no indication that the disclosed amino acids are meant to represent a "contiguous stretch of amino acids of SEQ ID NO:1" as asserted by

applicant and a skilled artisan would not interpret Tables 1-3 as supporting such a contiguous stretch of amino acids. As such, applicant has failed to demonstrate support for the recited contiguous range of amino acids in the claims.

[5] The new matter rejection of claim(s) 62-65 and 67-69 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record and the reasons stated below.

RESPONSE TO ARGUMENT: Applicant argues no new matter was added by amendment and that the claims refer to the original specification and information disclosed therein. Applicant argues that wording a claim to specifically point to specific data already disclosed is not new matter.

Applicant's argument is not found persuasive. As noted in the prior Office action, the examiner can find no support for a polypeptide consisting of a range of amino acids starting at position 14 and ending at position 229 of SEQ ID NO:1 at p. 16, lines 23-24, 29, and 31 of the specification. While applicant's cited support discloses the range of amino acids 42-98 and the range of amino acids 101-229, there is no support for a contiguous range of amino acids starting at position 42 and ending at position 229. Even assuming arguendo the specification provided support for the recited range of amino acids, the specification fails to provide support for claims 63-65.

Regarding claim 66, as support for the recited range of amino acids, applicants state, "[t]he end points of the polypeptide recited in new claim 66 are supported [at] page 16, line 24...and page 16, line 33 to page 17, line 1." The examiner acknowledges support for the range of amino acids 230-316 of SEQ ID NO:1 and further acknowledges support for a polypeptide consisting of this range of amino acids.

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However, the examiner can find no support for a polypeptide consisting of amino acids 230-316 of SEQ ID NO:1 and having a 3-D configuration defined by claims 67-69.

Applicant is invited to direct the examiner's attention to supporting disclosure for the limitations recited in claims 62-65 and 67-69.

[6] The written description rejection of claim(s) 1-6 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record and the reasons stated below.

In the response filed on 8/18/2005, applicant fails to address the rejection of record. Applicant is reminded that findings of the examiner which are not challenged are usually accepted as fact. *In re Kunzmann*, 326 F.2d 424, 140 USPQ 235 (CPA 1964).

[7] The scope of enablement rejection of claims 1-6 and 54-69 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record and for the reasons stated below.

RESPONSE TO ARGUMENT: In the response filed on 8/18/2005, applicant fails to address the rejection as it applies to claims 1-6. Further, applicant's argument fails to address the concerns of the examiner regarding the use of the polypeptides of claims 54-69. Applicant is reminded that findings of the examiner which are not challenged are usually accepted as fact. *In re Kunzmann*, 326 F.2d 424, 140 USPQ 235 (CPA 1964).

[8] The rejection of claim(s) 1-6 under 35 U.S.C. 102(e) as being anticipated by Wallis et al. (US Patent 6,225,098 B1) and the rejection of claim(s) 1-6 under 35 U.S.C. 102(b) as being anticipated by Database GenBank Accession Number P08373 are maintained for the reasons of record and the reasons stated below.

RESPONSE TO ARGUMENT: Applicant argues neither of the cited documents or the underlying documents of Database GenBank Accession Number P08373 discloses 3-D structural information as recited in claims 1-6.

Applicant's argument is not found persuasive. As noted in the prior Office action, there is no requirement that the claimed polypeptides exhibit the 3-D structural characteristic(s) as recited in the claims. The only requirement is that the claimed polypeptide comprise "at least a portion of an S. aureus MurB or MurB-like" FAD binding pocket or substrate binding pocket, wherein the FAD or substrate binding pocket is listed in Tables 1-3 and 4-6. In this case, the examiner has broadly interpreted "a portion" in accordance with MPEP 2111 as meaning a single amino acid and the polypeptides as disclosed by the cited references comprise such a "portion" of the FAD binding pocket of Tables 1-3 or the substrate binding pocket of Tables 4-6.

[9] In view of the non-entry of the amendment, the claim status is as follows:

Claims 1-6, 21-43, and 54-69 are pending.

Claims 21-43 are withdrawn from consideration.

Claims 1-6 and 54-69 are rejected.

No claim is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Thurs, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Steadman, Ph.D.
Primary Examiner
Art Unit 1656